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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAHIRO KAIWA, KENICHI SHIMA, YOICHI
TANIBAYASHI, HIROYUKI YAMAMOTO, MIOKO CHIKAMORI,
SEIGO TERAMACHI, and AKI KARIYA

Appeal 2009-010247
Application 10/070,331
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Massahiro Kaiwa et al. (Appellants) seek our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 1-11, 14-20, and 22-28. We have jurisdiction under 35 U.S.C. § 6(b) (2010). Claims 12-13 and 21 have been canceled.

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

This invention is a method and system “for supporting service which various service providers provide in relation to the location of a locating target person by using a network.” Specification 1:6-9.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A location information service supporting method comprising:

a location information obtaining service in which a location information service supporting gateway, situated between a first network including a mobile network and a second network, receives information from a mobile device in the first network used to indicate locating capability of the mobile device, selects at least one locating method, from a plurality of locating methods, for

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Dec. 9, 2008) and Reply Brief (“Reply Br.,” filed Apr. 7, 2009), and the Examiner’s Answer (“Answer,” mailed Feb. 9, 2009).

locating the mobile device based on the received information from the mobile device, and obtains a location information of the mobile device using the selected locating method indicating the location of a locating target person, the mobile device accompanied with the locating target person, so that a service provider provides a service relating to the location of the locating target person; and a location information sending service in which the location information service supporting gateway sends the location information to a destination designated by the service provider via the first or the second network.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

DeLorme	US 5,948,040	Sep. 7, 1999
Stewart	US 6,259,405 B1	Jul. 10, 2001
Steele	US 2002/0046084 A1	Apr. 18, 2002
Bide	US 2002/0052684 A1	May 2, 2002
Treyz	US 6,587,835 B1	Jul. 1, 2003
Cox	US 7,047,019 B1	May 16, 2006

The following rejections are before us for review:

1. Claims 1-11, 14-20, and 22-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stewart, Bide, and Treyz.
2. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Stewart, Bide, Treyz, Steele, DeLorme, and Cox.

ISSUES

The first issue is whether claims 1-17 and 23-25 are unpatentable over Stewart, Bide, and Treyz. Specifically, the issue is whether one of ordinary skill in the art would have been led by Stewart, Bide, and Treyz to a method which includes a location information service supporting gateway receives information from a mobile device in the first network used to indicate locating capability of the mobile device and selects at least one locating method from a plurality of locating methods. The rejection of claim 16 under 35 U.S.C. §103(a) as being unpatentable over Stewart, Bide, Treyz, Steele, DeLorme, and Cox also turns on this issue.

The second issue is whether claims 18-22 and 26-28 are unpatentable over Stewart, Bide, and Treyz. Specifically, the issue is whether one of ordinary skill in the art would have been led by Stewart, Bide, and Treyz to “a location information obtaining means for receiving information from a mobile device in the first network used to indicate locating capability of the mobile device, for selecting at least one location method, from a plurality of locating methods, for locating the mobile device based on the received.”

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Stewart describes that, in one embodiment, the geographical location of the access points are known and that provides the geographic location of the mobile user or personal computing device. Col. 6, ll. 14-17. *See also* col. 17, ll. 9-18.
2. Stewart describes that, in another embodiment, a personal computing device may provide the geographic location to the access point. Col. 6, ll. 20-24. *See also* col. 27, ll. 9-14.
3. Treyz describes determining a location of a handheld computing device when it is communicating with a wireless transmitter/receiver. Col. 23 ll. 28-31.
4. Treyz describes alternate methods of determining the location of a handheld computing device, including using GPS, differential GPS, etc. Col. 23, l. 37 – col. 24, l. 20.
5. Treyz describes that the various methods may be used “if desired.” *See Id.*
6. Bide describes a user position detector that determines a user’s coordinates using GPS, differential GPS, or “other convenient positioning technology.” Bides [0020]. *See also* Bide [0033].
Any differences between the claimed subject matter and the prior art
7. None of Stewart, Treyz, or Bide discloses a location information supporting gateway selecting at least one locating method from a plurality of locating methods based on information that is received from a mobile device and that indicates locating capability of the mobile device.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also* *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-11, 14-20, and 22-28 under §103(a) as being unpatentable over Stewart, Bide, and Treyz

Claims 1-17 and 23-25

The Examiner and the Appellants dispute whether one of ordinary skill in the art would have been led by the combination of Stewart, Bide and

Treyz to a method where a location information service supporting gateway receives information from a mobile device in the first network used to indicate locating capability of the mobile device and selects at least one locating method from a plurality of locating methods. App. Br. 5-9, Reply Br. 2-5, and Answer 10-18.

Claim 1 requires that the “location information service supporting gateway” performs the selecting of the locating method based on the information from the mobile device. While all of Stewart, Bide, and Treyz teach that alternate methods for locating if a mobile device exists (FF 1-6), none of Stewart, Bide, and Treyz teach a “location information service supporting gateway” that selects the locating method based on information received from the mobile device (FF 7). The references only teach that different methods could be used if desired (*see* FF 4).

The Examiner has failed to establish a *prima facie* showing of obviousness. Accordingly, we find that the Appellants have overcome the rejection of claim 1, and claims 2-17 and 23-25, dependent thereon, under 35 U.S.C. § 103(a) over Stewart, Bide, and Treyz.

Claims 18-22 and 26-28

Unlike claim 1, claim 18 recites an apparatus instead of method. Claim 18 requires “a location information obtaining means for receiving information from a mobile device in the first network used to indicate locating capability of the mobile device, for selecting at least one location method, from a plurality of locating methods, for locating the mobile device based on the received.” The Appellants and the Examiner dispute whether one of ordinary skill in the art would have been led by the combination of

Stewart, Bide and Treyz to this limitation. App. Br. 12- 15, Reply Br. 8, and Answer 22.

The limitation at issue is written in means-plus-function format. 35 U.S.C. § 112, paragraph 6 recites:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). . . . The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’ ” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

In the Appeal Brief, the Appellants describe that the services supporting gateway 1 in the Specification corresponds to the claimed means and cites page 11, lines 14-26 of Specification. App. Br. 4-5. Therefore, the limitation is construed to cover the service supporting gateway 1 described in the Specification or an equivalent.

The Examiner relies upon the same rationale to reject claim 18 as used to reject claim 1. *See* Answer 4-5. *See also* Answer 22. For the same reasons as discussed above, we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 18. Accordingly, we find that the Appellants have overcome the rejection of claim 18, and claims 19-22 and 26-28, dependent thereon, under 35 U.S.C. § 103(a) over Stewart, Bide, and Treyz.

The rejection of claim 16 under 35 U.S.C. §103(a) as being unpatentable over Stewart, Bide, Treyz, Steele, DeLorme, and Cox

This rejection is directed to a claim dependent on claim 1, whose rejection we have reversed above. For the same reasons, we will not sustain the rejection of claim 16 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

DECISION

The decision of the Examiner to reject claims 1-11, 14-20, and 22-28 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

REVERSED

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